

REMARKS

For the convenience of the Examiner set forth below is a recapitulation of the current status of the Claims in the present Application.

CLAIM	STATUS	DEPENDENCY
1	Currently amended	Independent
2	Original	1
3	Original	1
4	Canceled	—
5	Canceled	—
6	Original	1
7	New	1

Comments of Examiner Rochelle BLACKMAN have been reviewed carefully along with pertinent sections of the Patent Act, Patent Rules, the Manual of Patent Examining Procedure, legal treatises and relevant decisional law. The Application has been amended in accordance with Examiner BLACKMAN's requirements and allowance of the Application, as amended, is solicited earnestly.

Claim 1 has been amended to add clarity and to further distinguish the present invention from the prior art. No new matter has been added. Claim 1, as amended, is believed to be patentable.

New claim 7 has been added to add further clarity to the definition of the invention. No new matter has been added. Claim 7 is believed to be patentable.

Claims 1 and 3 have been rejected under 35 USC 102(b) as being anticipated by *Lehrer* (U.S. Patent 6,290,368).

Claims 1-3 and 6 have been rejected as being unpatentable over *Finizio et al.* (U.S. Patent Publication No. 2003/0095800) in view of *Lehrer* (U.S. Patent 6,290,368).

Reconsideration of the Examiners rejection of Claims 1-3 and 6 is requested on the following basis. An examination of the *Lehrer* patent and the *Finizio et al* publication reveals the following differences between the structures shown thereon, the structure of the present invention and the statements of the Examiner.

1. *Lehrer* shows a plurality of light members (33) and a first double convex lens 34 arranged in front of the light members (33). A second double convex lens 36 is arranged in front of the first single lens and a third double convex lens 37 is arranged between the first bi-convex lens and the second bi-convex lens. The third double bi-convex lens 37 is movable in order to adjust the size of the image (Col. 2 Lines 58-67). *Lehrer* thus incorporates three separate planes of refractive elements. *Lehrer* incorporates three refractive elements with each of the three refractive elements or lenses disposed in a plane thus forming three parallel planes.

In the present invention all of the lenses are in a single plate or single plane as claimed in claim 1 as amended.

2. The present invention does not incorporate a movable lens of any kind.

3. The present invention utilizes a plurality of lenses disposed in front of the light members as shown and as claimed in claim 1, as amended.

4. The present invention provides a plurality of lenses 43 which are in a single plate 40. The plurality of lenses are thus in a single plane. This feature is not shown in any of the cited references.

5. The Examiner has stated that:

Finizio discloses projector light device (22) comprising: a housing (20) including a supporting panel (see 72) provided therein, a board (see PCB 70 in pg. 3, paragraph [0034]) attached to said panel, a plurality of light members (68) attached to said board for generating lights, and a plate (74) disposed in front of said board, arranged in front of said light members, for concentrating the light generated by said light members, and for increasing projecting distances of the lights generated by said light members, a cover (40) disposed in front of said plate, and including a transparent sheet (see 60) provided therein, and arranged in front of said light members,

The Examiner has stated further:

It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the "plate" of the "projector light device" of *Finizio* reference with a lens, as taught by *Lehrer* for the purpose of focusing the light beams of the "plurality of the light members" and/or adjusting the size of image of light projected by the "plurality of light members" (see col.1, lines 46-48, col. 2, lines 55-57, and col. 2, line 67 to col. 3, line 8).

6. Examination of the *Finizio et al.* reference reveals that plate 74 is not a device for concentrating light as stated by the Examiner but rather an infrared passband filter (Paragraph 0035). The *Finizio et al.* reference thus does not anticipate the present invention or does it render the present invention obvious because the elements of *Finizio et al.* cited by the Examiner do not perform and can not perform the functions of a lens and therefore do not function in a manner similar to the elements of the present invention. The elements of the present invention specifically the plate including a plurality of lenses which has been shown and described and which is claimed in claim 1, as currently amended, in combination with the plurality of light members has not been shown nor described in the references. Claim 1, as amended, is believed to be patentable and reconsideration is requested.

7. The Examiner has stated that it would be obvious to provide the plate of *Finizio et al.* with a lens as taught by *Lehrer*. The incorporation of a lens as shown in *Lehrer* on an optical filter even if this were done would still not produce the apparatus of the present invention because the present invention does not use a lens as taught by *Lehrer* but a

plurality of lenses each in line with a lighting element.

The addition of a lens of *Lehrer* to the filter plate of *Finizio et al.* is not an obvious combination of elements as suggested by the Examiner because the basic requirements of the *Finizio et al* device teaches away from the incorporation of a lens. *Finizio et al.* requires a broad illuminating beam of infrared light to illuminate a subject for operation of the camera for security surveillance. The addition of the lens of *Lehrer* and provide only partial illumination thereby rendering the *Finizio et al.* partially or entirely inoperative. The combination of elements of *Finizio et al.* and *Lehrer* is not an obvious combination which leads to the present invention but rather a forced bringing together of disparate elements which does not result in a functionally operative apparatus and does not lead to the present invention.

8. *Lehrer* shows a plurality of lamps or light members 33 which form an illuminated object of extended size, the light from which travels along a single optical axis which passes through the optical centers of the lens 34, then the lens 37 and finally the lens 36. The light from all of the lamps 33 thus pass through three lenses which are in line. This result in significant optical losses.

In the present invention as specified in claim 1, as amended, there is provided a plurality of lamps however, because the plurality of lamps are disposed in a single plate or plane with the center of each lamp in line with a single lens and the light from each

individual lamp passes through only a single lens. This structure is not shown in the references and claim 1, as amended is, believed to be patentable.

There is no teaching in the *Lehrer* and *Finizio* references taken alone or in combination which leads to the structure of the present invention.

For the above reasons the application of the *Lehrer* and *Finizio* et al references is not considered to be appropriate.

In a famous footnote in *Hodosh v. Block Drug Co.*, 786 F.2d 1136, 229 USPQ 182, 1987 (Fed. Cir., 1986), the Federal Circuit set out five principles; with citations to previous cases, regarding obviousness determinations under Section 103. The footnote (as to the first four principles) reads as follows:

Our comments on the district court's obviousness determination generally include the following tenets of patent law that must be adhered to when applying § 103;

(1) the claimed invention must be considered as a whole (35 USC 103); see, e.g. *Jones v. Harty*, 727 F.2d 1524, 1529, 220 USPQ 1021, 1024 (Fed. Cir., 1984) (though the differences between claimed invention and prior art may seem slight, it may also have been taken the key to advancement of the art);

(2) the references must be considered as whole and suggest the desirability and thus the obviousness of making the combination (see, e.g., *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 1462, 220 USPQ 481, 488 (Fed. Cir. 1984);

(3) the references must be viewed without the benefit of hindsight vision afforded by the claimed invention (e.g. *W.I. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F2d 1540, 1553, 220 USPQ 303, 313 (Fed. Cir. 1983));

(4) “ought to be tired” is not the standard with which obviousness is determined (*Jones, supra*, 727 F.2d at 1530, 220, USPQ at 1026).

The fifth tenet or principle deals with the presumption of validity and is not germane to the issues hereinvolved.

It is submitted that the Examiner’s position in applying *Lehrer* and *Finizio et al.* is contrary to the above-quoted tents of the Court of Appeals for the Federal Circuit, particularly the first three. When the claimed invention is considered fairly as whole, it is self-evident that Applicant’s invention is not rendered obvious by the cited prior art, whether

considered alone or in combination.

The statutory presumption of 35 USC § 282 makes an invention presumptively non-obvious unless the Examiner can demonstrate the “the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skills in the art to which said subject matter pertains,” 35 USC § 103.

Obviousness is a legal conclusion based on four factual inquiries: (1) the scope and content of the prior art; (2) the differences between the prior art and the claimed invention; (3) the level of the ordinary skill when the invention was made; and (4) any other objective considerations including evidence of commercial success, copying, and a long-felt need in the industry. *Continental Can Co. v. Monsanto Co.*, 948 F2d 1264, 1270, 1273 (Fed. Cir. 1991) (citing *Graham v. Deere Co.*, 383 US 1.17 (1966)). The decision maker is not to apply hindsight, but must analyze obviousness from the viewpoint of a person skilled in the art prior to the disclosure of the present invention *Panduit Corp. v. Dennis Mfg., Co.* 810 F2d 1561, 1566 (Fed. Cir.), *cert denied*, 481 US 1052 (1987).

Objective evidence of non-obviousness (long-felt need, commercial success, copying must always be taken into account; it is not merely “icing on the cake”. *Hybrietch, Inc. v. Monoclonal Antibodies, Inc.*, 802 F2d 12367, 1380 (Fed. Cir. 1986), *cert denied*, 4580 US 947 (1987). The Federal Circuit has stated that:

(I)ndeed, evidence of secondary considerations may often be the most probative and cogent evidence in the record it may often establish that an invention appearing to have been obvious in light of the prior art was not.

The Examiner has attempted to reconstruct Applicant's invention from selecting bits and pieces from *Lehrer* and *Finizio et al.* The cherry picking exercise is just the sort of hindsight reconstruction which the Federal Circuit has warned against repeatedly. Nothing in the prior art suggests to a person of ordinary skill in the art to combine those elements in the way Applicant did to arrive at his invention. *Panduit Corp.* 810 F2d at 1568. The prior art existed for many years and yet those skilled in the art never created a light device having light concentrating device comparable to Applicant's. See *Id* at 1577 (that skilled workers did not create (patented) invention, despite existence of elements in the prior art, is evidence of non-obviousness).

The objective evidence, such as whether the invention solves a long-standing problem, weigh strongly in favor of conclusion that Applicant's invention is not obvious. *Continental Can*, 948 F2d at 1273.

A Petition covering a three (3) month extension of time to respond to the Office Action dated March 8, 2005 to and including September 8, 2005 and a check in the amount

of Five Hundred and Ten Dollars (\$510.00) covering the petition fee are enclosed.

Also enclosed herewith is a Information Disclosure Statement by Applicant and a check in the amount of One Hundred Eighty Dollars (\$180.00) covering the Information Disclosure fee.

The status of the claims is as follows:

Claims 4 and 5 have been canceled.

Claim 1 is currently amended.

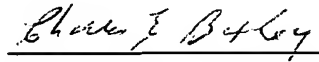
Claims 2 and 3 are original.

Claim 7 is new.

In view of the foregoing amendments, submissions and explanations, it is believed that claims 1-3, 6 and 7, as amended, are in condition for allowance. An early Notice of Allowance on the Application will be appreciated.

Courtesy, cooperation and skill of Examiner Rochelle BLACKMAN are appreciated and acknowledged.

Respectfully,



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Dated: New York, New York
September 1, 2005

Enclosures:

Petition;
Information Disclosure Statement; and
Check in the amount of \$690.00.